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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,441	02/08/2001	Masahiko Maeda	Q63016	4617

7590 06/18/2002

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EXAMINER

ZACHARIA, RAMSEY E

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 06/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-8

Office Action Summary

Application No.

09/762,441

Applicant(s)

MAEDA ET AL.

Examiner

Ramsey Zacharia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,4,6. 6) ☐ Other: .

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on August 10, 1998. It is noted, however, that the PCT office has not forwarded a copy of the application as required.

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

2. Claim 7 is objected to because of the following informalities: the term "urehtane" on line 4 the claim appears to be a typographical error. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 15 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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5. Claim 15 is rendered indefinite because it is unclear whether the claim depends from claim 1 or from claim 6.

6. The term "small" in claim 19 is a relative term which renders the claim indefinite. The term "small" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Use of the term "small" renders the size of the leather articles indefinite.

Claim Rejections - 35 USC § 103

7. For the purpose of examination, claim 15 is taken to depend from claim 6 and "small leather articles" are taken to be any leather article that is not explicitly referred to as a large article.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saitoh et al. (U.S. Patent 5,229,461) in view of Dessaint et al. (U.S. Patent 4,295,976).

Saitoh et al. teach a coating composition comprising a vinylidene fluoride copolymer which yields a film having excellent weatherability and stain resistance (column 1, lines 54-60). The copolymer comprises units of vinylidene fluoride (see formula I) and units having a hydroxyl functional group (formula III) (column 2, lines 17-47). The composition further

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comprises a curing agent, such as an isocyanate, an amino resin, or an acid anhydride, that is reactive with the hydroxyl groups in the copolymer (column 9, lines 7-29). The coating may be applied directed to the substrate or over a primer coating, such as an acrylic coating (column 11, lines 1-11).

Regarding the stain resistance limitations in claims 1 and 2, the cracking resistance limitations in claims 3 and 4, and the hydroxyl value limitation of claim 9, these are taken to material properties of the coating composition. Since the coating composition of Saitoh et al. appears to be the same as that of the instant invention (especially since page 7, lines 17-19 of the instant specification cites the composition of JP-A-4-28707 as a suitable curable fluorine-containing resin and U.S. Patent 5,229,461 is an English language equivalent of JP-A-4-28707 as shown by Derwent abstract 1991-347997).

Regarding the limitations of claim 5, while Saitoh et al. is silent with respect to the weight of the coating, the coating weight of a protective coating is a known to affect the degree of protection (e.g. stain resistance and weatherability). As such, it would have been obvious to one having ordinary skill in the art at the time the invention was made to optimize the weight of the coating, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Saitoh et al. do not teach applying the composition to leather, however, the composition is taught as being applied on substrates such as metal, wood, concrete, plastic, and the like (column 11, lines 5-8).

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Dessaint et al. disclose that materials such as metals, plastics, wood materials, concrete, and leather are considered equivalent substrates for fluorinated anti-staining coatings (column 1, lines 5-11).

Dessaint et al. shows that for anti-staining fluorinated coatings metal, wood, concrete, plastic, and leather are equivalent structure substrates. Therefore, because these substrates were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute a leather substrate for the metal, wood, concrete, plastic, or the like material used as the substrate by Saitoh et al.

Therefore the invention of claims 1-19 would have been obvious to one of ordinary skill in the art at the time the inventions were made.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (703) 305-0503. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for non after-final correspondences and (703) 872-9311 for after-final correspondences.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'R. Zacharia', with a stylized flourish at the end.

Ramsey Zacharia

Patent Examiner

Technology Center 1700

6/15/02